

**REMARKS**

Applicants acknowledge receipt of the Office Action mailed September 26, 2007.

In the Office Action, the Examiner objected to the drawings; objected to the specification; rejected claims 69-83 and 86-90 under 35 U.S.C. § 112, second paragraph; rejected claims 69-75, 78, 81-83, and 86-90 under 35 U.S.C. § 102(b) as being anticipated by *Copeland et al.* (U.S. Patent No. 5,595,707); and rejected claims 69-73, 75-77, 79, 80, and 86-90 under 35 U.S.C. § 102(b) as being anticipated by *Wilkie et al.* (U.S. Patent No. 4,092,952).

In this Amendment, Applicants amend claims 69, 76, 86, 87, and 90. Upon entry of this Amendment, claims 69-79, 81-83, and 86-90 will remain pending, with claims 49-68, 84, 85, and 91-98 withdrawn from consideration. Of the claims under examination, claims 69 and 86 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 69, 76, 86, 87, and 90. No new matter has been introduced.

Applicants traverse the objections and rejections above and respectfully request reconsideration for at least the reasons that follow.

**I. OBJECTION TO THE DRAWINGS**

The drawings stand objected to under 37 C.F.R. § 1.83(a) as allegedly failing to show every feature of the invention specified in the claims. Specifically, the Examiner asserts, "the 'sample immerser' and the 'fluid recycle element'. . . must be shown or the feature(s) canceled from the claim(s)." (*Office Action*, p. 2, paragraph 3). Applicants respectfully submit that the claimed "sample immerser" is illustrated in FIGs. 7-10 by reference numeral "101," which denotes a "fluid containment element" or a dip tank into

which vertically disposed slides 7v may be immersed. (*Specification*, p. 10, ll. 20-24).

With respect to the claimed “fluid recycle element” in claim 80, Applicants have cancelled claim 80, without prejudice or disclaimer. Applicants therefore request that the objection to the drawings be withdrawn.

## **II. OBJECTION TO THE SPECIFICATION**

The specification stands objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. In particular, the Examiner asserts that “[c]orrection of the following is required: ‘sample immerser element’ and ‘fluid recycle element’ (claim 80).” (*Office Action*, p. 3, paragraph 4). Applicants respectfully disagree and submit proper antecedent basis has been provided for both the “sample immerser element” and the “fluid recycle element,” for example, on page 10, lines 20-24 and page 6, lines 7-12 of the specification, respectively. Applicants therefore request that the objection to the specification be withdrawn.

## **III. 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION**

Claims 69-83 and 86-90 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Examiner asserts, with respect to claim 90, “[i]t is not clear how the ‘sample immerser element’ includes a slide rack with a plurality of slides since the sample immerser element is defined in parent claim 86 as ‘adapted to immerse the at least one fluid’ . . . [W]hat element(s) corresponds to the ‘sample immerser element’[?]” (*Office Action*, pp. 3-4). Applicants submit that the rejection of claims 69-83 and 86-90 has been rendered moot by the amendments to claim 90. Specifically, Applicants have amended claim 90 to recite, *inter alia*, “[a]n automatic

stainer system according to claim 86, further comprising a slide rack having the slide, the slide rack being configured to accommodate a plurality of slides.” Applicants therefore request that the rejection of claims 69-83 and 86-90 under 35 U.S.C. § 112, second paragraph, be withdrawn.

#### **IV. 35 U.S.C. § 102(b) REJECTIONS**

Applicants traverse the rejection of claims 69-75, 78, 81-83, and 86-90 under 35 U.S.C. § 102(b) as being anticipated by *Copeland*. Applicants respectfully submit that amended independent claims 69 and 86 distinguish over *Copeland* at least for the reasons described below.

In order to properly establish that *Copeland* anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

*Copeland* appears to disclose an automated immunostaining apparatus including a reagent application zone and a reagent supply zone. The apparatus has a carousel slide support supporting a plurality of slide supports thereon, and drive means engaging the carousel slide support for consecutively positioning each of the plurality of slide supports in the reagent application zone. The apparatus also has a carousel reagent support having a plurality of reagent container supports thereon, and drive means engaging the carousel for rotating the carousel and positioning a preselected reagent container support in the reagent supply zone. (*Copeland*, Abstract).

*Copeland*, however, does not disclose a sample immerser element including a slide immerser element for submerging a substantially vertically disposed slide with at least one tissue sample in at least one fluid, as required by claims 69 and 86.

The Examiner asserts that “*Copeland* . . . teaches a plurality of sample immerser elements. The Office considers the sample immerser element to read on *Copeland*’s heated air supply chamber 28 and manifold 30 and rinse stations (i.e., 200, 202, 204, 220, 222, 224; see Figs. 13 and 17).” (*Office Action*, p. 5, ll. 3-6). Applicants respectfully disagree. The alleged “heated air supply chamber 28,” “manifold 30,” and “rinse stations,” do not submerge a substantially vertically disposed slide with at least one tissue sample in at least one fluid.

Accordingly, with respect to independent claims 69 and 86, *Copeland* fails to teach Applicants’ claimed combination, including, *inter alia*:

a sample immerser element including a slide immerser element for submerging a substantially vertically disposed slide with . . . at least one tissue sample in . . . at least one fluid.

Since *Copeland* fails to disclose each and every element of independent claims 69 and 86, *Copeland* fails to anticipate claims 69 and 86, and claims 70-75, 78, 81-83, and 87-90, that correspondingly depend from claims 69 and 86. Therefore, Applicants respectfully request that this rejection be withdrawn.

Applicants traverse the rejection of claims 69-73, 75-77, 79, 80, and 86-90 under 35 U.S.C. § 102(b) as being anticipated by *Wilkie*. Applicants respectfully submit that

amended independent claims 69 and 86 distinguish over *Wilkie* at least for the reasons described below.

*Wilkie* appears to disclose an automatic slide stainer including a hollow enclosed framework with a base and a cover, the cover having a top annular platform. A dish containing a stain solution is mounted upon the platform. A dish of increased width is mounted upon the platform adjacent to the first dish and adapted to contain another stain solution. A reservoir tank having an outlet is mounted upon the framework and adapted to contain a rinse solution. (*Wilkie*, Abstract).

*Wilkie*, however, does not disclose a sample immerser element including a slide immerser element for submerging a substantially vertically disposed slide with at least one tissue sample in at least one fluid, as required by claims 69 and 86.

Instead, *Wilkie* discloses that “[t]he slide retainers 207-213 have a raised secured position such as shown in FIG. 2 . . . Each of the slide retainers has a horizontal position as shown in dash lines at S in FIG. 2. This corresponds to the slide emersion position . . .” (emphases added). (*Wilkie*, col. 6, ll. 63-68 and col. 7, ll. 17-18).

Accordingly, with respect to independent claims 69 and 86, *Wilkie* fails to teach Applicants’ claimed combination, including, *inter alia*:

a sample immerser element including a slide immerser element for submerging a substantially vertically disposed slide with . . . at least one tissue sample in . . . at least one fluid (emphasis added).

Since *Wilkie* fails to disclose each and every element of independent claims 69 and 86, *Wilkie* fails to anticipate claims 69 and 86, and claims 70-73, 75-77, 79, 80, and

87-90, that correspondingly depend from claims 69 and 86. Therefore, Applicants respectfully request that this rejection be withdrawn.

**V. CONCLUSION**

Applicants respectfully submit that claims 69-79, 81-83, and 86-90 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

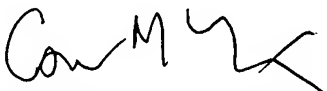
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: January 25, 2008

By:  Reg. No. 48,638  
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